

REMARKS/ARGUMENTS

Initially, Applicants would like to express appreciation to the Examiner for the detailed Official Action provided.

Applicants submit that the instant amendment is proper for entry after final rejection. Applicants note that no question of new matter nor any new issues are raised in entering the instant amendment of the claims and that no new search would be required.

Moreover, Applicants submit that the instant amendment places the application in condition for allowance, or at least in better form for appeal.

Accordingly, Applicants request that the Examiner enter the instant amendment, consider the merits of the same, and indicate the allowability of the present application and each of the pending claims.

Upon entry of the above amendments claims 1, 2, 11 and 12 will have been amended. Claims 1-12 are currently pending. Applicants respectfully request reconsideration of the outstanding rejections, and allowance of all the claims pending in the present application.

In the Official Action, the Examiner has objected to the drawings for not showing the inverter case “proximate a discharge side of the compression mechanism.” In this regard, Applicants submit that claim 2 has been amended to clarify that the inverter case is attached to an end wall of the housing at a side of said compression mechanism having a discharge port (e.g., see reference numeral 31 as shown in the non-limiting embodiment of Figure 1). Accordingly, the objection to the drawings is believed to be moot and should be withdrawn.

In the Official Action, the Examiner has objected to claims 11 and 12 for containing informalities. More specifically, the Examiner has indicated that double brackets (“[[]]”) should be used instead of single brackets (“[]”) when deleting terms from the claims. Accordingly, Applicants have once again presented amendments to claims 11 and 12 indicating the changes to the claims which were intended by the previous amendment. Thus, the objection to the claims is believed to be moot and should be withdrawn.

In the Official Action the Examiner has rejected claims 1-12 under 35 U.S.C. § 112, second paragraph. In setting forth the rejection, the Examiner asserts that the use of the term “proximate” makes the claim indefinite. Without acquiescing to the propriety of the Examiner’s rejection, claims 1 and 2 have been amended to remove the recitation of “proximate” from the claims. Accordingly, the rejection of claims 1-12 under 35 U.S.C. § 112 is believed to be moot and should be withdrawn.

In the Official Action, the Examiner has rejected claims 1, 3 and 5-7 under 35 U.S.C. § 102(b) as being anticipated by SAITO et al. (U.S. Pub. No. 2002/0039532).

Without acquiescing to the propriety of the Examiner’s rejection, Applicants have amended independent claim 1 solely in order to expedite prosecution of the present application. In this regard, Applicants note that SAITO fails to disclose the combination of elements as recited in claim 1.

In particular, claim 1 sets forth an electric compressor including, inter alia, an intake passage which returns fluid from an outside of the compressor into the suction port, wherein the suction port is provided in the inverter case, and wherein the intake passage has a thermal binding portion which thermally binds the intake passage to the

inverter, the thermal binding portion having a plurality of fins projecting into a fluid path of the intake passage, the inverter case having an end surface connected to an end wall of the housing so as to define at least part of the intake passage, and the thermal binding portion being positioned within the inverter case.

Applicants submit that SAITO lacks any disclosure of at least the above noted combination of elements.

In setting forth the rejection, the Examiner asserts that SAITO discloses the general structure of the presently claimed invention. More particularly, the Examiner asserts that SAITO discloses a thermal binding portion (104) having a plurality of fins (106).

However, contrary to the Examiner's assertions, the device of SAITO is very different structurally from the presently claimed invention. More specifically, Applicants submit that SAITO clearly shows an annular flange of the suction housing 100 (which the Examiner considers to be the inverter case) being connected (via 53b) to the intermediate housing 52.

Thus, SAITO does not disclose at least the presently claimed inverter case having an end surface connected to an end wall of the housing so as to define at least part of the intake passage, and the thermal binding portion being positioned within the inverter case, as generally recited in claim 1.

Further, Applicants note that absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claim 1, as well as claims 3 and 5-7, dependent therefrom, these

claims are not anticipated thereby. Further, all pending dependent claims recite additional features that further define the present invention over the prior art.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection under 35 U.S.C. § 102 and allow all pending claims in the present application.

In the Official Action, the Examiner has rejected claims 2, 4 and 8-12 under 35 U.S.C. § 103(a) as being unpatentable over SAITO in view of MAKINO et al. (U.S. Patent No. 6,808,372).

Further, without acquiescing to the propriety of the Examiner's rejection, Applicants have amended independent claim 2 solely in order to expedite prosecution of the present application.

In this regard, Applicants note that SAITO and MAKINO, alone or in any properly reasoned combination, do not disclose the combination of elements as recited in claim 2.

In particular, claim 2 sets forth an electric compressor including, inter alia, an intake passage which returns fluid to the suction port, wherein the suction port is provided in the inverter case, and wherein the intake passage has a thermal binding portion which thermally binds the intake passage to the inverter, wherein an air layer is provided between the intake passage and the end wall, and wherein the thermal binding portion has a plurality of fins projecting into a fluid path of the intake passage, the inverter case having an end surface connected to an end wall of the housing so as to define at least part of the intake passage, and the thermal binding portion being positioned within the inverter case.

Applicants submit that SAITO and MAKINO, alone or in any properly reasoned combination, lack any disclosure of at least the above noted combination of elements.

In this regard, as discussed supra, SAITO does not disclose at least the presently claimed inverter case having an end surface connected to an end wall of the housing so as to define at least part of the intake passage, and the thermal binding portion being positioned within the inverter case.

Therefore, independent claim 2 is allowable for at least reasons generally similar to claim 1, as argued supra.

Additionally, Applicants note that, claim 2 sets forth an electric compressor including, inter alia, an inverter case of the inverter being externally attached to an end wall of the housing in an axial direction at a side of the compression mechanism having a discharge port, the end wall having a suction port which returns fluid to the compression mechanism.

In setting forth the rejection, the Examiner asserts that MAKINO discloses the inverter case (126) being externally attached to an end wall of the housing in an axial direction proximate a discharge side from the compression mechanism, and mounting legs (34) configured to mount the compressor either horizontally or at an incline with respect to the axial direction.

However, contrary to the Examiner's assertions, there are no elements which can be reasonably be considered to be a "suction port" provided in the side wall to which the cover 126, which the Examiner has characterized as being the presently claimed inverter case, is attached (see, Figure 1). Thus, MAKINO does not disclose at least the presently

claimed inverter being externally attached to an end wall of the housing having a suction part, as generally recited in claim 2.

Further, Applicants submit that dependent claims 4 and 8-12 are at least patentable due to their respective dependencies from claims 1 and 2 for the reasons noted above. In this regard, Applicants note that the Examiner has provided no proper reasoning for supplying the above-noted deficiencies in the teachings of SAITO and MAKINO.

In this regard, Applicants submits that none of the applied prior art disclose at least the presently claimed inverter case having an end surface connected to an end wall of the housing so as to define at least part of the intake passage, and the thermal binding portion being positioned within the inverter case; nor does the applied prior art disclose an inverter case of the inverter being externally attached to an end wall of the housing in an axial direction at a side of the compression mechanism having a discharge port, the end wall having a suction port which returns fluid to the compression mechanism, as generally recited in claims 1 and 2.

Accordingly, the rejections of claims 4 and 8-12 under 35 U.S.C. § 103(a) are improper and should be withdrawn.

In view of the amendments and arguments herein, Applicants submit that independent claims 1 and 2 are in condition for allowance. With regard to dependent claims 3-12 Applicants assert that they are allowable on their own merit, as well as because of their respective dependencies from independent claims 1 and 2, which Applicants have shown to be allowable.

Thus, it is respectfully submitted that all of the claims in the present application are clearly patentable over the references cited by the Examiner, either alone or in combination, and an indication to such effect is respectfully requested, in due course.

SUMMARY

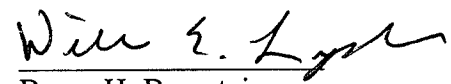
Applicants submit that the present application is in condition for allowance, and respectfully request an indication to that effect. Applicants have argued the allowability of the claims and pointed out deficiencies of the applied references. Accordingly, reconsideration of the outstanding Official Action and allowance of the present application and all the claims therein are respectfully requested and is now believed to be appropriate.

Applicants note the status of the present application as being an after final rejection and with respect to such status believes that there is a clear basis for the entry of the present amendment consistent with 37 C.F.R. § 1.116. Applicants note amendments after final are not entered as a matter of right; however, Applicants submit that the present amendment does not raise new issues or the question of new matter. Moreover, the present amendment clearly places the present application in condition for allowance.

Applicants note that this amendment is being made to advance prosecution of the application to allowance and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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